

### REMARKS

Independent claims 1 and 34 remain in their original form. New independent claim 43 and dependent claims 44-46 have been added. Written description support for claims 43-46 are found throughout the original specification, for example, at page 8, line 26 through page 10, line 19; at FIGS. 1A-1C and 6A-9. No new matter has been by these amendments. Accordingly, claims 1-16 and 34-46 (including independent claims 1, 34 and 43) are pending.

#### Claims 1-16 and 41-42

Independent claim 1 was rejected under 35 U.S.C. § 103 as being unpatentable over Dixon (U.S. Patent No. 6,432,461), in view of Golchert (U.S. Patent No. 4,024,287), in further view of Waters (U.S. Patent No. 6,376,000), and in further view of Borkland (U.S. Pat. No. 2,468,731). Applicants respectfully submit that the Office Action has failed to set forth a *prima facie* case of obviousness because: (1) the Office Action failed to set forth a suggestion found in the prior art for proposed combination, and (2) the proposed combination would not disclose all of the claim elements.

First, the Office Action failed to set forth a motivation for the proposed combination of Dixon, Golchert, Waters, and Borkland, thereby failing to meet the requirements under MPEP § 2143.01. In one example, the Office Action contends that Borkland describes forming a three-dimensional version of an original two-dimensional image. Then, the only apparent motivation set forth in the Office Action to combine Borkland with the other three references is that "it was a known method of forming a three-dimensional version of an original two-dimensional image." In other words, the Office Action asserts that Borkland discloses one claim element, and disclosure of this one claim element by itself provides the motivation to combine with other references. Such reasoning is improper under MPEP § 2143.01, which clearly states "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination.*" MPEP § 2143.01(III) (emphasis added). Thus, even if Borkland discloses a process for printing a three-dimensional version of a two-dimensional image, Borkland and all other prior art of record fail to

***suggest the desirability*** of the proposed combination, which is the burden that the Office Action must satisfy.

Indeed, the only teaching that suggests the desirability of the Applicants' claimed method is found in Applicants' original specification. Applicants respectfully submit that the Office Action has merely combined isolated disclosures in the four references without offering the necessary suggestions or motivations found in the prior art for the proposed combination—an effect of “a hindsight [reconstruction] wherein that which only the inventor taught is used against its teacher.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”) Therefore, the Office Action failed to set forth a suggestion found in the prior art to combine Dixon, Golchert, Waters, and Borkland as proposed by the Office Action, as required by MPEP § 2143.01.

Second, even if there was a suggestion in the prior art to combine Dixon, Golchert, Waters, and Borkland as proposed by the Office Action, such a combination would not disclose all of the elements of independent claim 1, as required by MPEP § 2143.03. Unlike independent claim 1, none of the four references describe forming a three dimensional impression in the image-bearing carrier “to form a non-planar relief mold for a comestible material.” Rather, Dixon discloses that silkscreen-printed “sugarpaste” carrier is shaped to form an edible decoration itself (e.g., placed on the surface of a cake), not a non-planar relief mold for a comestible material as set forth in claim 1. (See Dixon at col. 1, lines 3, 6-8; col. 2, lines 57-59; FIG. 1.) Borkland discloses that the plastic sheet carrier is plate-printed on a surface that becomes the exterior surface of the face-shaped mask (FIG. 8), with no description of a non-planar relief mold for a comestible material. (See Borkland at col. 3, lines 24-28 and 67-74; FIGS. 6-8.) Golchert and Waters describe that the image-bearing carriers remain flat (e.g., to transfer inks onto flat surfaces) and do not describe a non-planar relief mold for a comestible material. (See Golchert at col. 2, lines 16-65; Waters at col. 4, lines 10-65; FIGS. 2-3 and 6.)

Accordingly, not only did the Office Action fail to set forth a motivation found in the prior art for the proposed combination (as required by MPEP § 2143.01), but the proposed

combination would fail to disclose all of the elements of independent claim 1 (as required by MPEP § 2143.03). Applicants respectfully submit that independent claim 1 and dependent claims 2-16 and 41-42 are patentable over the cited references of record and are in condition for allowance.

#### Claims 34-40

Independent claim 34 was rejected under 35 U.S.C. § 103 as being unpatentable over Dixon, in view of Golchert, in further view of Waters, and in further view of Borkland. Applicants repeat that the Office Action failed to explain how the prior art of record suggests the desirability of the combination of the four references, as required by MPEP § 2143.01. (*See, supra*, pages 8-9.) In addition, the proposed combination would not disclose all of the claim elements, as required by MPEP § 2143.03.

Unlike claim 34, Dixon, Golchert, Waters, and Borkland—alone or in combination—do not describe “measuring misalignment of the deformed outline to the three-dimensional impression and creating an adjusted two-dimensional artwork based on the original two-dimensional artwork and the measurements.” Borkland discloses that an embossed plastic article is printed with colors on its exterior surface, and then the plastic article is flattened by application of heat. (*See* Borkland, FIGS. 3-4.) A master printing plate is made from the color decoration on the flattened article (FIGS. 5-6), but nowhere does Borkland disclose an operation of “measuring misalignment” and creating an adjusted two-dimensional artwork “based on the original two-dimensional artwork and the measurements.”

Dixon, Golchert, and Waters are also lacking. Dixon teaches that either (1) an “artist paints/airbrushes/colours by hand to simulate the final finished appearance of the decoration” or (2) an “artist scans into the computer the original single dimensional artwork,” which is used to directly make “printing screens for the silk screen printing process.” (*See* Dixon at col. 5, lines 24-50.) Golchert describes that a user may trace or copy an original image onto a flat sheet (transfer medium 22), and then that image is transferred to a flat surface such as a cake top. (*See* Golchert at col. 2, lines 16-65.) Waters describes that an original image printed onto a flat edible

paper is transferred to another flat surface in a chocolate molding process. (*See* Waters at col. 4, lines 10-65; FIGS. 2-3 and 6.)

Accordingly, even if there was a suggestion in the prior art to combine Dixon, Golchert, Waters, and Borkland as proposed by the Office, such a combination would not disclose all of the elements of independent claim 34, as required by MPEP § 2143.03. Applicants respectfully submit that independent claim 34 and dependent claims 35-40 are patentable over the cited references of record and are in condition for allowance.

#### New Claims 43-46

Independent claim 43 describes a method for creating a relief mold that includes applying an image using an edible ink composition onto a substantially planar carrier, forming a three dimensional impression in the carrier to form a non-planar relief mold for a comestible material, and “temporarily storing the carrier in a moisture-barrier package after forming the three dimensional impression in the carrier and before the comestible material contacts the edible ink composition applied to the carrier.”

Unlike claim 43, neither Dixon, Golchert, Waters, Borkland, nor any other reference cited in the record discloses the claimed method that includes “temporarily storing the carrier in a moisture-barrier package after forming the three dimensional impression in the carrier and before the comestible material contacts the edible ink composition applied to the carrier.” Applicants respectfully submit that independent claim 43 and dependent claims 44-46 are patentable over the cited references of record and are in condition for allowance.

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In view of the foregoing, Applicants request reconsideration and withdrawal of the cited rejections. Claims 1-16 and 34-46 are in condition for allowance. No fee is believed to be due at this time. If necessary, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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